

REMARKS

Claims 1-32 were originally presented in the subject application. Claims 33 and 34 were added in a Response dated July 2, 2004. Claims 10, 20-22 and 32-34 were canceled without prejudice in an Amendment dated May 23, 2005. Claims 1, 11 and 23 were amended, and claims 2, 12 and 24 canceled without prejudice, in an Amendment dated April 20, 2006. No claims have herein been added. Therefore, claims 1, 3-9, 11, 13-19, 23 and 25-31 remain in this case.

The addition of new matter has been scrupulously avoided. In that regard, the common amendment to independent claims moves up limitations from the relevant dependent claims, now canceled.

Applicants respectfully request reconsideration and withdrawal of the sole remaining ground of rejection.

35 U.S.C. §103 Rejection

The final Office Action rejected claims 1, 3-9, 11, 13-19, 23 and 25-31 under 35 U.S.C. §103(a), as allegedly obvious over Burk (“UNIX System Administrator’s Edition”) in view of Deitel (“C & C++ Multimedia Cyber Classroom”). Applicants respectfully, but most strenuously, traverse this rejection.

Claim 1 has been amended to include the substance of prior claim 5. Thus, claim 1 now recites choosing one or more locations associated with the computer program in which the one or more additional items to be searched are to be included, wherein locations not associated with the computer program are not chosen.

Against the substance of prior claim 5, the final Office Action cites to Burk at page 726. However, the cited section of Burk teaches searching by time or size limiting the results, neither of which are factors related to searching locations not associated with the computer program being searched. For example, even with these limiting search factors, the FIND command would still look at the entire directory tree under the directory specified in the command. As noted elsewhere in Burk, the FIND command by default looks in the directory specified in the

command and all subdirectories thereof. Thus, Applicants submit that Burk teaches searching in locations that are not associated with the computer program. Note that the present application at numbered paragraph 0002 specifically points out the FIND command as a time-consuming type of search that the invention seeks to improve upon.

The final Office Action was virtually identical to the prior Office Action, except for items (d), (e) and (f) on pages 18 and 19 thereof. In response to those sections, Applicants point out they did *not* argue, as alleged in item (d), that the preamble states to facilitate the searching of text by selectively choosing where to search for the text. Instead, what was actually argued was that the field of endeavor in the application, i.e., numbered paragraph 0001 of the application, states what was alleged, not the claim preamble. Looking at the field of endeavor of the application is simply part of the standard non-analogous art test, repeated below for the convenience of the Examiner.

In addition, the final Office Action continues to allude to some sort of issue with the language of the determining step of claim 1 (*in the prior response, Applicants requested further clarification of this point, but did not receive the same in the final Office Action, thus, Applicants submit the finality of the rejection should be withdrawn and the requested clarification provided, or the issue withdrawn*):

“Applicants’ are claiming the claim 1 negatively even though search tools in the current invention are meant for debugging a computer program.”

“Claiming improperly for search tools to debug a computer program using the rules of a computer programming language.”

Applicants submit there is no prohibition against the style of claiming used, and that the “absent” limitation further defines the “determining” aspect. If there is a perceived concern with the language, the Examiner is again requested to more clearly set forth those concerns and cite support in the rules, since any basis is unclear from the noted comments above.

Claim 1 also recites, for example, determining one or more additional items to be searched for the text, the determining using one or more language specific rules of the computer

program, the determining being defined by the computer program and being absent user specification of the one or more additional items.

Against the aspect that the determining is absent user specification of the one or more additional items to be searched for the text, the final Office Action cites to the following command in Burk:

```
grep -i -n '#include' filename
```

However, Applicants submit that there is no determining absent user specification in the cited GREP command. The file to be searched is specified by the user within the command, and all statements in that file are searched for the “#include” statement. The final Office Action even admits this at page 5, stating that the command “will search for all include statements in the **user specification file**[.]” To clarify, in case it has not been clear to date, claim 1 recites that the user does not specify what item(s) (e.g., where) to search for the text, which is defined by the computer program. Applicants submit that no additional items beyond those in the user-specified file are searched by the noted GREP command. Thus, the item(s) to be searched in the GREP command are clearly specified by the user, and thus, are not absent user specification as claimed.

Against the above aspect of claim 1, the final Office Action also cites to Burk at page 145, alleging that repeated use of the FIND command reads thereon. However, Applicants submit that simply looking by default in all subdirectories below the noted directory in the command is not actively “determining” as claimed.

Moreover, the determining is also recited to use one or more language specific rules of the computer program. Thus, the computer program determines whether to search additional items based on the language used. Applicants submit this aspect is not taught or suggested by either of the cited references or their combination.

As another example, claim 1 recites searching for the text by the search tool in at least one additional item of the one or more additional items, in response to the determining.

Against this aspect of claim 1, the final Office Action cites to the “#include” preprocessor directive of Deitel. However, the #include directive searches for a file and inserts a copy of the

file in place of the directive. Thus, the Deitel directive is neither a text search tool, nor does it search the text of a computer program, much less doing so in response to the claimed aspect of determining. Note this paragraph is not related to the non-analogous art issue (see below for that), but a reason why Deitel does not substantively read on claim 1 under the obviousness rejection. Section (a) of the “Response to Arguments” in the final Office Action seemed to indicate otherwise.

As and additional, separate basis for patentability over the cited art, Applicants continue to contend that Deitel is non-analogous art, and that Deitel is improperly combined with Burk. However, for the sake of brevity, Applicants refer the Examiner to Applicants’ response dated March 23, 2006 for those arguments. The “Response to Arguments” correctly sets forth the basic test for non-analogous art in section (b), then fails to address the specific steps of the test applied to Deitel alone.

The determination that a reference is non-analogous art involves two steps. *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products Inc.*, 30 U.S.P.Q.2d 1377, 1379 (Fed. Cir. 1994); *In re Wood*, 599 F.2d 1032, 202 U.S.P.Q. 171, 174 (CCPA 1979). First, the reference alone is reviewed as to whether it is within the field of the Applicants' endeavor. *Id.* Second, if the reference is not in the field of endeavor, then a determination is made as to whether the reference is reasonably pertinent to the particular problem the inventor sought to solve. *Id.*

In determining what the field of endeavor is in the first part of the test, courts have looked to the field of endeavor set out in a patent or patent application. See, e.g., *In re Wood and Eversole*, 202 U.S.P.Q. 171 (CCPA 1979).

In the present case, the field of endeavor in numbered paragraph 0001 of the present application is set out as relating, in general, to searching techniques, and in particular, to facilitating the searching for text of computer programs by selectively choosing where to search for the text. In contrast, Deitel (the actual cited sections thereof) is directed to the “#include” and “#define” preprocessor directives in the C and C++ programming languages. The #include directive (the portion substantively cited) searches for files, not text, and replace the directive with a copy of the file. The same is true even when Deitel is compared to the preamble of

claim 1, for example, which recites searching for text of computer programs. Therefore, Applicants submit that Deitel is not within the field of applicant's endeavor.

Since Deitel is not within the field of Applicants' endeavor, it must be determined in the second step of the non-analogous art test whether Deitel is reasonably pertinent to the particular problem sought to be solved by the present invention. In this case, as noted in the Background section of the present application, the problem is that existing text search tools search too many places, which is time consuming and tends to produce false positives. Again, though, Deitel is not a text search tool, but describes a preprocessor directive for finding files and replacing the directive with the contents of the file. Thus, Applicants submit Deitel is not reasonably pertinent to the problem sought to be solved.

Thus, Applicants submit that Deitel is improperly cited against the present application as non-analogous art.

Therefore, for all the reasons noted above, Applicants submit that claim 1 cannot be rendered obvious over Burk in view of Deitel.

Independent claims 11 and 23 include aspects similar to those argued above with respect to claim 1. Thus, the remarks regarding claim 1 are equally applicable thereto. Therefore, Applicants submit that claims 11 and 23 likewise cannot be obviated by Burk in view of Deitel.

Applicants submit that the dependent claims are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For example, claim 3 recites that the one or more additional items comprise one or more files. Against claim 3, the final Office Action cites to Burk teaching the FIND command, searching for all file names with a particular name that are printed on the screen.

However, again Applicants submit that no additional files are being searched. If the cited command is present, all files are searched. Applicants submit there is a difference between performing a search everywhere (the cited FIND command), and a computer program determining additional items to be searched beyond those specified by the user. Recall that claim 1 recites identifying text to be searched, searching for the text in a targeted item at a

targeted location, and then determining (as defined by the program) one or more additional items to be searched, the determining being absent user specification of the one or more additional items.

Therefore, Applicants submit that claim 3 cannot be obviated over Burk in view of Deitel.

Claims 13 and 25 include aspects similar to those argued above with respect to claim 3. Thus, the remarks regarding claim 3 are equally applicable thereto. Therefore, Applicants submit that claims 13 and 25 likewise cannot be obviated over Burk in view of Deitel.

Claim 4 recites that the one or more additional items comprise one or more classes. Against claim 4, the final Office Action alleges that searching for classes is the same as searching for names, citing a Burk name search command. However, as set forth in the present application beginning at numbered paragraph 0030, there is a difference. In the JAVA example given, it involves, in part, the use of the CLASSPATH environment variable.

Therefore, the Applicants submit that claim 4 cannot be obviated over Burk in view of Deitel.

Claims 14 and 26 include aspects similar to those argued above with respect to claim 4. Thus, the remarks regarding claim 4 are equally applicable thereto. Therefore, Applicants submit that claims 14 and 26 likewise cannot be obviated over Burk in view of Deitel.

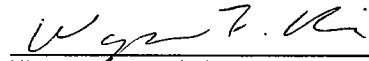
CONCLUSION

Applicants submit that the dependent claims not specifically addressed herein are allowable for the same reasons as the independent claims from which they directly or ultimately depend, as well as for their additional limitations.

For all the above reasons, Applicants maintain that the claims of the subject application define patentable subject matter and earnestly request allowance of claims 1, 3-9, 11, 13-19, 23 and 25-31.

If a telephone conference would be of assistance in advancing prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided.

Respectfully submitted,



Wayne F. Reinke
Attorney for Applicants
Registration No.: 36,650

Dated: March 9, 2007.

HESLIN ROTHENBERG FARLEY & MESITI P.C.

5 Columbia Circle

Albany, New York 12203-5160

Telephone: (518) 452-5600

Facsimile: (518) 452-5579